

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAR 22 2006

PAT & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MICHAEL R. ARNESON and WILLIAM R. BANDY

Application No. 09/496,960

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on March 4, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On March 1, 2004, appellants filed an Information Disclosure Statement (IDS). It is not clear from the record whether the examiner considered the IDS submitted or whether the examiner notified appellants of why the submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

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Also, a review of the file indicates that the appeal brief filed September 22, 2004 does not fully comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application indicates that the following appropriate sections are missing from the appeal brief filed September 22, 2004:

- 1) "Evidence appendix" as set forth in 37 CFR § 41.37(c)(1)(ix); and

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2) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c)(1)(x).

Furthermore, the examiner's answer filed on November 26, 2004 does not comply with the headings as set forth in the new rules under 37 CFR § 41.37(c). Correction is required.

A supplemental appeal brief and a revised examiner's answer that is in compliance with 37 CFR § 41.37 are required. For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Also, on January 26, 2005, appellants filed a reply brief and a request for oral hearing in response to the examiner's answer mailed November 26, 2004. The reply brief is not listed in the Patent Application Location and Monitoring (PALM) system. Before further review, entry of the reply brief in PALM is required.

In addition, there is no indication on the record whether or not the examiner has responded to the reply brief. Section 1208.03 of the Manual of Patent Examining Procedure (8<sup>th</sup> ed., Aug. 2001) states:

[A]ppellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's

answer. . . . The primary must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02.

Accordingly, it is

ORDERED that this application be returned to the examiner to: 1) consider the Information Disclosure Statement filed March 1, 2004; 2) provide appropriate written notification by the examiner to appellants of such consideration 3) hold the appeal brief of September 22, 2004 defective; 4) request appellants to file a supplemental appeal brief in compliance with 37 CFR § 41.37; 5) vacate the examiner's answer and provide a revised examiner's answer in accordance with the new rules effective September 13, 2004 and in response to the supplemental appeal brief; 6) entry of the reply brief filed January 26, 2005 in PALM; 7) proper response to the reply brief; and 8) for such further action as may be appropriate.

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